

10/068,333

Docket No.: NEREUS.012C1

May 18, 2005

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Please Direct All Correspondence to Customer Number 20995



AMENDMENT / RESPONSE TRANSMITTAL

Applicant : Palladino et al.
 Patent No : 6,881,857 B2
 Issued : April 19, 2005
 For : TRICYCLIC DITERPENE
 DERIVATIVES
 Examiner : Ralph J. Gitomer
 Art Unit : 1651

CERTIFICATE OF MAILING

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

May 18, 2005

(Date)

Marc T. Morley, Reg. No. 52,051

Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Sir:

Transmitted herewith for filing in the above-identified patent are the following enclosures:

- Request for Reconsideration of Patent Term Adjustment Under 37 C.F.R. 1.705(d) in 4 pages.
- A check in the amount of \$200 as set forth in 37 C.F.R. §1.18(e) is enclosed.
- Return prepaid postcard.
- Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Marc T. Morley
 Registration No. 52,051
 Attorney of Record
 Customer No. 20,995
 (619) 235-8550



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Palladino et al.
Appl. No. : 10/068,333
Filed : Feb. 4, 2002
For : TRICYCLIC DITERPENE
DERIVATIVES
Examiner : Ralph J. Gitomer
Group Art Unit : 1651
Patent No. : 6,881,857

CERTIFICATE OF MAILING

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May 18, 2005

(Date)

Marc T. Morley, Reg. No. 52,051

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. 1.705(d)

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

| 05/20/2005 MBIZUNE2 00000071 10068333
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Dear Sir:

This petition is filed under 37 C.F.R. § 1.705(d), requesting reconsideration of the patent term adjustment, and is submitted within two months of the April 19, 2005 issuance of the above-identified patent. The fee set forth in 37 C.F.R. § 1.18(e) is enclosed.

Applicants submit that the 70 day reduction in patent term adjustment (from the 213 day extension provided on Form PTOL-85 with the Notice of Allowance to the 143 day extension provided on the Issue Notification) is unwarranted and hereby petition for the reinstatement of the 70 days removed from the patent term adjustment. The relevant prosecution history as well as the bases for Applicants' arguments under Rules 1.704(a), 1.704(c)(10) and 1.705(d) are set forth below. Applicants note that the above-referenced patent is subject to a terminal disclaimer with respect to U.S. Patent No. 6,365,768.

STATEMENT OF FACTS

A Notice of Allowance in connection with the above-referenced application was mailed to Applicants on November 9, 2004, and indicated that the patent term adjustment would be 213 days if the issue fee was paid within three months of the mailing date of the notice (*i.e.*, by

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February 9, 2005) and the patent issued less than twenty-eight (28) weeks after the Notice (*i.e.*, by May 24, 2005).¹ The Notice also contained an Examiner's Amendment, altering the title from "Novel Tricyclic D_iterpene Derivatives" to "Tricyclic D_eterpene Derivatives." This amendment inexplicably introduced a typographical error into the word "d_iterpene." The Examiner also stated in the Notice of Allowance that if this change was not acceptable, Applicants may submit a Rule 312 amendment, but must do so no later than the payment of the issue fee.

On February 8, 2005, Applicants paid the issue fee and, consistent with the Examiner's mandate, submitted an amendment under Rule 312 removing the typographical error and changing "D_eterpene" back to "D_iterpene." In the Issue Notification received on April 6, 2005, the patent term adjustment was listed as 143 days (70 days less than that stated in the Notice of Allowance).

REMARKS

Applicants' Rule 312 Amendment was filed merely to correct a typographical error that was unilaterally introduced by the Examiner when mailing the Notice of Allowance. See M.P.E.P. § 2732 (stating that a "request to correct an error or omission in the 'Notice of Allowance'" will "not be considered a failure to engage in reasonable efforts to conclude processing or examination of an application.") Accordingly, Applicants respectfully request reconsideration of patent term adjustment under 37 C.F.R. § 1.705(d).

Rule 704(a) provides that the period of adjustment will be reduced in circumstances, laid out in §1.704(c), "by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution (processing or examination) of the application." Section 2732 of the M.P.E.P. 2732 further explains: "The submission of the following papers after a 'Notice of Allowance' is not considered a failure to engage in reasonable efforts to conclude processing or examination of an application: . . . (6) a response to the examiner's reasons for allowance or a request to correct an error or omission in the "Notice of Allowance" or "Notice of Allowability." (emphasis in original)

In this case, the error in the Notice of Allowance was introduced unilaterally by the Examiner's Amendment to the title of the application. Therefore, Applicants' request to correct the error in the Notice of Allowance, though technically in the form of a Rule 312 Amendment,

¹ Both deadlines were met. The issue fee was paid February 8, 2005, and the patent issued April 19, 2005.

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should not be considered a failure to engage in reasonable efforts to conclude processing or examination of the application. As such, the patent term should be restored to 213 days.

Applicants respectfully submit that they filed the Rule 312 Amendment pursuant to the Examiner's express invitation, and did so merely to correct the typographical error that was introduced by the Examiner's Amendment. Such action does not constitute a failure by Applicants "to engage in reasonable efforts to conclude prosecution (processing or examination) of the application," as described in Rule 704(a). To the contrary, Applicants filed their Rule 312 amendment promptly, along with payment of the issue fee, to ensure that the patent would issue without delay and without the error in the title, as it did on April 19, 2005.

Furthermore, Applicants respectfully assert that imposing a reduction under Rule 704(c)(10) unfairly penalizes Applicants for complying with the Examiner's instruction to file a Rule 312 Amendment to correct the Examiner's own error. To impose this reduction would require Applicants to make a Hobson's choice: (i) file the Rule 312 Amendment, as suggested by the Examiner and lose a portion of the due patent term extension, (ii) demand that prosecution be reopened so that the Examiner can enter a further Examiner's Amendment to correct the error, further delaying issuance, or (iii) do nothing until the patent issued, and run the risk of having a Certificate of Correction denied as improper because Applicants failed to file the Rule 312 Amendment when they has the opportunity to do so. None of these options is satisfactory.

Patent Term Calculation

Applicants do not dispute the patent term calculation reported on Form PTOL-85, mailed along with the Notice of Allowance. The total adjustment of patent term due to examination delay should be 306 days and the total reduction of adjustment of patent term should be 93 days. Accordingly, Applicants submit that the net patent term adjustment should be 213 days.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the correct patent term adjustment for the above-identified patent should be 213 days. The submission of the Rule 312 Amendment was necessary to correct a Patent Office mistake. As such, the Rule 312 Amendment does not constitute a failure "to engage in reasonable efforts to conclude prosecution (processing or examination) of the application" under 37 C.F.R. §1.704(a). Under both the letter and the spirit of this rule, no reduction to the patent term extension is proper. Accordingly, the

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original patent term calculation indicated in the Notice of Allowance of 213 days should be restored.

The undersigned has made a good faith effort to set forth all relevant facts and bases for adjustment involved. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call the undersigned to discuss such issues.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 5/18/05

By: 
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